

**REMARKS**

Upon entry of the claim amendments, Claims 11-18 will be all the claims pending in the application.

Applicants have canceled Claims 1-10, which are the issued claims of U.S. Patent No. 6,646,046. Accordingly, Applicants respectfully request withdrawal of the §101 **same invention double patenting rejection** presented at Section No. 2 (page 2) of the Office Action.

Applicants have amended Claim 11 by rewriting it as an independent claim. Original Claim 11 depended from Claim 1, and Applicants have hereby incorporated the subject matter of Claim 1 into Claim 11.

New Claim 17 is the combination of original Claims 1, 5, and 11.

New Claim 18 is the combination of original Claims 1, 9, and 11.

No new matter has been added.

Referring to Section No. 5 at pages 3 and 4 of the Office Action, Claims 11-16 are rejected under **35 U.S.C. § 102(b)** as being anticipated by or, in the alternative, under **35 U.S.C. § 103(a)** as being unpatentable over U.S. Patent No. 4,033,918 to Hauber et al., U.S. Patent No. 4,413,082 to Gleichenhagen et al., U.S. Patent No. 4,492,724 to Allbright et al., U.S. Patent No. 4,992,501 to Hanninen et al., or DE 4432368.

Applicants respectfully traverse.

Allbright discloses at Table 2 a pressure-sensitive adhesive composition comprising two water-insoluble polyacrylates, two polyacrylic acids, ethoxylated adducts, and water. Allbright does not disclose the presence of a water-incompatible solvent. Thus, Allbright does not disclose a pressure-sensitive adhesive composition, comprising a pressure-sensitive adhesive composition formed from, *inter alia*, a water-incompatible solvent C. Independent Claim 11 further requires the water and solvent to have been essentially removed from the pressure-sensitive adhesive composition, which is contrary to what is stated at Table 2 of Allbright.

In addition, independent Claim 11 requires the adhesive composition to have, in a dry state, water solubility according to TAPPI UM 213.

The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that characteristic. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Here, inherency has not been established for the element “water solubility according to TAPPI UM 213” because a basis in fact and/or technical reasoning to reasonably support the determination that the specific “water solubility according to TAPPI UM 213” characteristic necessarily flows from the teachings of the applied prior art has not been identified.

For the following reasons, the subject matter of new Claims 17 and 18 is also patentable.

None of Gleichenhagen, Hanninen or DE ‘368 specifically discloses a polymer as the water-insoluble component B or a composition containing a polymer as the water-insoluble component B.

The specific tackifying resin disclosed in each of Gleichenhagen, Hanninen and DE ‘368, such as modified or unmodified rosin resins, including colophony (also called rosin) and hydrogenated disproportionated rosins are not polymers, but rather blends of different molecules.

Specifically, it is known by one of ordinary skill in the art that rosin or colophony is a mixture of about 90% rosin acids and 10% neutral compounds (fatty acid esters, terpene alcohols and hydrocarbons). Resin acids are the major components of natural resin and are typically on the basis of diterpenes. Thus, rosins must not be confused with polymerized rosin esters, the latter representing a specific modification in that the particular type of compound has undergone polymerization. Such polymerized rosin esters as disclosed at page 14, line 4, and Example 3 of the specification, are not expressly disclosed in any of Gleichenhagen, Hanninen and DE ‘368.

Hauber discloses a pressure-sensitive adhesive comprising a sodium ammonium salt of a copolymer of acrylic and methacrylic acids and polyvinylmethylether, two aqueous polyacrylate

AMENDMENT

U.S. Appln. No. 10/670,565

dispersions, dioctylphthalate, and an aromatic polyglycol ether. Dioctylphthalate is not a polymer.

None of Hauber, Gleichenhagen, Hanninen or DE '368 discloses the components in the specific ranges recited in new Claim 18.

Furthermore, it is an object of the present invention to provide a water-soluble pressure-sensitive adhesive composition for use in the papermaking process or paper splicing in printing processes. Specifically, the pressure-sensitive adhesive composition should have sufficient tack, while at the same time allowing good peelability.

According to the invention of Claim 17, this object has been solved by using the combination of a specific component B containing a polymer and a water-incompatible solvent C. As described at page 12, line 12, through page 16, line 12, of the specification, the combination of these two specific components is important in order to supplement the desired properties, in particular, to achieve sufficient tack and sufficient cohesive force. None of the cited art references teaches the criticality of the combination of components B and C in order to achieve these effects.

According to the invention of new Claim 18, the object of the present invention has been solved by selecting the components of the claimed pressure-sensitive adhesive composition in specific amounts. As is described throughout the present application and is demonstrated by means of Examples 1 to 3, in contrast to Comparative Example 2, good effects with respect to the adhesiveness can be achieved by selecting the components in the ranges as recited in new Claim 18. None of the prior art documents describes the importance of choosing the components, in particular component B in the amounts as recited in new Claim 18. In addition, there is no pointer directing the person skilled in the art to the criticality of the specific combination in the pressure-sensitive adhesive composition in order to solve the object of the present invention.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the §102/§103 rejection of the claims.

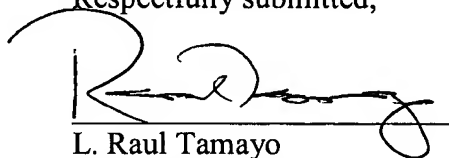
AMENDMENT

U.S. Appln. No. 10/670,565

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



L. Raul Tamayo  
Registration No. 47,125

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 5, 2005